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09/490,495	01/25/2000	Trevor Blumenau	12722.00170	7210

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EXAMINER

NGUYEN, CUONG H

ART UNIT PAPER NUMBER

2165

DATE MAILED: 04/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

cd

Office Action Summary

Application No.
09/490,495

Applicant(s)
Blumenau

Examiner
Cuong H. Nguyen

Art Unit
2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 16, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 66-85 and 101-241 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 66-85 and 101-241 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

DETAILED ACTION

1. This Office Action is the answer to the communication received on 1/16/2002 (the amendment), which paper has been placed of record in the file.
2. Claims **66-85, 101-241** are pending in this application.

Response to Amendment

3. Applicant' arguments received by OIPE - USPTO on 1/16/2002 have been fully considered but they are not persuasive with previous cited references for 35 U.S.C. §103(a) rejections. All other rejections on 35 USC 112 1st & 2nd para. are withdrawn.
4. Rule 37 CFR 1.111(b) requires that applicant **MUST "distinctly and specifically point out errors"** in the examiner action. On pages 25, 2nd para. of the response dated on 1/16/2002, there were no specific response to the examiner rejections besides an applicant's assertion of **"none of the cited references discloses the monitoring of a display device to determine an extent to which a specific content is displayed"**. The examiner requests the claims' elaboration of the claimed term "an extent" since his interpretation of the claims' language are still similar as in previous action; and therefore, similar rationales and references for 35 USC 103(a) for obvious rejections previously applied are repeated herein.
5. During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. The

reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.

6. Claims' language could be read-on by cited references and no reasonable distinguishing limitation has been made in claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ 2d 1057 (Fed. Cir. 1993).

7. *In re Gorman*, 18 USPQ2d 1885 (CA FC), the court ruled: "Patent and Trademark Office's reliance on teachings of large number of references in rejecting patent application for obviousness does not, without more, weigh against holding of obviousness on appeal, since criterion is not number of references, but whether references are in fields which are same as or analogous to field of invention, and whether their teachings would, taken as whole, have made invention obvious to person skilled in that field."

8. The examiner recognized that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references.

9. *In re Nomiya*, 184 USPQ 607 (CCPA 1975), the court ruled: "However, there is no requirement that a motivation to make the modification be expressly articulated. The test for

combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re **Simon**, 174 USPQ 114 (CCPA 1972); In re **McLaughlin**, 170 USPQ 209 (CCPA 1971)".

10. The examiner submits that the reasons for rejection are obvious (vs. cited prior arts) with **claims' language**. In re **Mraz**, 59 CCPA, F.2d, 173 USPQ 25, 28 (1972), the court ruled: "Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter".

B. In re **Prater**, 162 USPQ 541 (CCPA 1969), the court ruled: During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. Reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is quite different from reading limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.

C. Ex parte **Pfeiffer**, 135 USPQ 31 (BdPatApp&Int 1961) , the court ruled: "As to the rejection of the claims on the prior art references, we do not agree with the appellant that such structural limitations as are not disclosed by the references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. To be entitled to such weight in method claims, the recited structural limitations therein must

affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here."

D. One cannot show non-obviousness by attacking references individually where rejections are based on combinations of references.

E. *In re Merck & Co., Inc.*, 231 USPQ 375 (CA FC 1986), the court rules: "Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references."

F. *In re Nievelt*, 179 USPQ 224 (CCPA 1973), the court rules: "Combining teachings of references does not involve an ability to combine their specific structures."

G. *In re Bozek*, 163 USPQ 545 (CCPA 1969), the court rules: "Test for obviousness is not whether features of one reference may be bodily incorporated into the other to produce claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in pertinent art."

I. "Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

J. In re **Hiniker Co.**, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998), the court rules: "**The name of the game is the claim.**"

K. "Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims". See **In re Self**, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). When given their broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have directed an artisan of ordinary skill to make the combination cited by the examiner. ... discloses a structure that meets the claim limitations. See **Giles Sutherland Rich**, Extend of Protection and Interpretation of Claims -- American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990) ("The US is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claim.")

L. The test for combining references is not what the individual references themselves suggest but rather what the combination of the disclosures taken as a whole would suggest to one of ordinary skill in the art. In re **Kuderna**, 165 USPQ 575 (CCPA 1970).

M. It is reasonable that various modifications of prior art would be apparent to those skilled in the art at the

time of invention without departing from the scope and spirit of these inventions. Although cited inventions may have been described in connection with specific preferred embodiments, it should be understood that their limitations as disclosed should not be unduly limited to such specific embodiments. Furthermore, in response to the amendment, the examiner submits court cases which are relevant to applicant's arguments.

N. In re **Sheckler**, 168 USPQ 716 (CCPA 1971), the court ruled:

It is not necessary that a reference actually suggest changes or possible improvements which applicant made. The PTO can show that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the cited references.

O. In re **Bozek**, 163 USPQ 545 (CCPA 1969), the court ruled:

"Reference disclosure must be evaluated for all that it fairly suggests and not only for what is indicated as preferred."

P. **Merck & Co. Inc. v. Biocraft Laboratories Inc.**, 10 USPQ2d 1843 (CA FC 1989), the court ruled:

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments.

Q. In re **Heck**, 216 USPQ 1038 (Fed. Cir. 1983), the court ruled:

"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain."

R. In re Keller, Terry, and Davies, 208 USPQ 871 (CCPA 1981), the court ruled: "It is not necessary that device shown in one reference can be physically inserted into device shown in other reference to justify combining their teachings in support of rejection."; and "Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

S. In re Conrad, 169 USPQ 170 (CCPA 1971), the court ruled:

The test for obviousness under 35 U.S.C. 103 is not the express suggestion of the claimed invention in any or all of the references but what the references taken collectively would suggest.

T. About a basis for claiming criticality:

It is an established principle of law that a limitation merely with respect to proportions in a composition of matter or process will not support patentability unless such limitation is "critical". (e.g. , **Minerals Separation, Ltd. v. Hyde**, 242 U.S. 261 (1916)).

U. The type of claims here are very common among software patents, and claiming the desired functional features of the invention, without limitation to its implementation. That is, the pending claims can be viewed as covering the steps necessary from a business perspective to achieve the desired business goal of providing content monitoring. Thus, software, claimed at the level of useful functionality must have implementation limitations. Claims need to be limited to low level manipulations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 66-85, 101-241 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Curran** et al. (UK Patent GB 2250112A), in view of **Brown** (Using Netscape 2 - Special Edition), and further in view of **Capps** (US Pat. 5,634,100 - 5/27/1997).

Curran et al. disclose a system/method/computer-readable medium for monitoring displays by a computer system, comprising:

- instructions for causing the content to be displayed by a computer system (inherently in **Curran** et al.'s patent); ~~the~~ means/step/instructions for monitoring a position/a change in time of an image on a display screen (of a content characteristic) (see **Curran** et al., pp. 4:9-12, 5:3-8, 17-23); and

- means/step/instructions for monitoring/evaluating/comparing/judging a position/a change in time of an image on a display screen (see **Curran** et al., pp. 5:6-7 and 5:13-16).

Curran et al. fail to discuss a means for determining a duration of each time if a display is hidden; and transmitting monitoring information between sites.

However, **Brown** (Using Netscape 2 - Special Edition) further suggests there is a means/instructions for determining a duration of each time if a display is hidden by other images (see **Brown**, pp. 270, 805, 720-721) (this is also a limitation in claim 66 about evaluating a position of a content display). Furthermore, **Capps** clearly add more weights to that fact with Figs. 7 & 10, 12:64-67, and

Brown also obviously suggests that transmitting monitoring information between sites.

The examiner submits that a step of receiving a specific program (e.g. a monitoring program) over the Internet (e.g., in claim 148); downloading data to a specific address, downloading time, uploading data/(time

duration) (e.g., in claim 167) is already well-known in computer art.

The examiner also submits that that all communications over a network (e.g. Internet) to different servers coupled to that network are notoriously well-known to a person with skills in the art of networking. The limitation of claim 172 is obvious from claim 167 with uploading specific data (an identifying mark/indicia and a related time amount).

The examiner also submits that these claims' limitations are obvious because **Curran** et al., **Capps**, and **Brown** need not necessary spelled-out exactly claimed languages, because their suggestions also directed to a similar system for monitor displaying/controlling; their limitations are not limited to described embodiments in these disclosures. It is reasonable that various modifications and variations of their systems/steps would be apparent to those skilled in the art at the time of invention without departing from the scope and spirit of the invention. Although their disclosures have been described in connection with specific preferred embodiments, it should be understood that their limitations should not be unduly limited to such specific embodiments. It is to be understood that various changes and modifications can be effected therein by one skilled in the art without departing from the spirit or scope of the cited prior art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to

implement **Curran** et al. 's system with **Brown & Capps** 's suggestions because it increases a completeness in monitoring a display of content by a computer system.

Conclusion

12. Claims **66-85, 101-241** are rejected.

13. These cited references are considered pertinent to applicant's disclosure.

- Curran et al. (UK Pat. GB 2250112A), Computer testing capture device, 05/27/1992.
- Shibata et al., (US Pat. 5,835,923 - 11/10/1998), Contents information transmitting/viewing system and method therefor.
- Pan, (US Pat. 5,926,168 -- 7/20/1999), Remote pointers for interactive televisions.
- Tsai, (US Pat. 5,495,581 - 2/27/1996), Method and apparatus for linking a document with associated reference information using pattern matching.
- Capps (US Pat. 5,634,100 - 5/27/1997), System and method for event parameter interdependence and adjustment with pen input.
- Halliday, FastCAD offers speed, 3-D rendering features, InfoWorld, v13n49, pp.98-105, 12/09/1991.
- Halliday, Product Comparison: High-End CAD, InfoWorld, v13n16, pp.55-75, 4/22/1991.
- Lubow, An engineer's guide to AutoCAD, Industrial Engineering, v19n8, pp.ESC18-ESC20, 8/1987.

- Parks et al., New workstation from SunRiver Corp. Offers highest CAD performance at affordable price, Business Wire, s1 p1, 6/11/1990.

- McGrath, The tail-less mouse: is innovative mouse missing more than just a tail?, Computer Graphics World, v11, p117(2), 10/1988.

- Lombardi, Windows Word Processors: InfoWorld tests the tools and features in six of the high-end graphical products, InfoWorld, v14n6, pp.78-96, 2/10/1992.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen (703)305-4553. The examiner can normally be reached on Monday-Friday from 7:15 AM-3:15 PM.

Any response to this action should be mailed to:

Amendment

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to: (703) 746-7239 (Official)

Or: (703) 746-5572 (RightFax) (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Dr. Arlington. VA., 4th. Fl.
(Receptionist).

09/490,495
Art Unit 2165

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900.

Cuonghuynguyen
Primary Examiner
April 01, 2002